

Notice of Allowability

Application No.

10/510,069

Examiner

Zachary C. Tucker

Applicant(s)

BILODEAU ET AL.

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 30 January 2007.
2. ☒ The allowed claim(s) is/are 2-8, 10 and 11.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____ |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

Response to Amendment

As requested by applicants in the correspondence filed 30 January 2007 (hereinafter "present amendment"), which is in reply to the Office action mailed 7 November 2006 (hereinafter "previous Office action"), claims 1, 9, 12-18, 24 and 25 have been cancelled and claims 2, 3 and 6-8 have been amended. The specification has been amended also, at pages 27, 28, 31-35, 37, 40, 41, 44-50, 100 and 102, as requested in the present amendment.

Status of Claim Rejections - 35 USC § 112

In the previous Office action, claims 12-17, 24 and 24 were rejected under the first paragraph of this statute, for failing to meet the enablement requirement. Specifically, methods of treating cancer, generally, were found not to be enabled by the disclosure, and methods wherein inhibition of "one or more isoforms of Akt in a mammal" comprising administering a therapeutically effective amount of a compound according to the present invention were similarly found not to be enabled.

Applicants' cancellation of all rejected claims has rendered the rejections of record moot.

Obviousness-Type Double Patenting

A provisional rejection of instant claims 1-18, 24 and 25, as being unpatentable over claims 1-41 of copending U.S. patent application serial No. 10/510,068 was set forth in the previous Office action.

Applicants' present amendment does not address this rejection. However, because the rejection was provisional, and because the instant application is in condition for allowance but for the provisional obviousness-type double patenting rejection, the rejection is hereby withdrawn. MPEP 804(B) directs the examiner to withdraw a provisional

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obviousness-type double patenting rejection if that rejection is the only rejection remaining, and the application is otherwise in condition for allowance, if the application being examined is the "base invention" out of two applications filed on the same day. Since that is the situation presently at hand, it is proper to withdraw the double patenting rejection.

Status of Claim Rejections - 35 USC § 102

In the previous Office action, claims 1, 9 and 12 were rejected under 35 U.S.C. 102(b) as being anticipated by Venugapalan et al, *Indian Journal of Chemistry*, vol. 30B, page s777-783 (191) or IN 166761, also to Venugapalan et al.

Claims 1, 9 and 12 all have been cancelled, therefore, the rejection based on Venugapalan et al is now moot.

Status of Claim Objections

Claims 6-8 were objected to in the previous Office action, for spelling errors in the compound names. The present amendment corrects those errors, therefore the objections are withdrawn.

Declaration

Because non-initialed alterations to co-inventor Mark E. Duggan's entry in the declaration were made, the declaration was objected to in the previous Office action, under 37 C.F.R. 1.67(a). The filing of a declaration with Mark E. Duggan's entry properly initialed at the alterations has obviated the objection to the declaration.

Specification

Compound names were misspelled in the instant specification, in the same manner as were compound names misspelled in claims 6-8. So, in the previous Office action, the specification was objected to. The present amendment has corrected those errors, and therefore the objection to the specification is withdrawn.

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Allowable Subject Matter

Claims 2-8, 10 and 11 are allowed.

The following is an examiner's statement of reasons for allowance:

All rejections and objections of record have been overcome by applicants' present amendment. Subject matter according to instant claims 2-8, 10 and 11 is neither disclosed, taught nor suggested in the prior art. The closest prior art with respect to the subject matter of the allowed claims is the Venugapalan et al references (journal article and Indian patent), and US 7,034,026 (Barnett et al), which was summarized and contrasted with the present invention on page 10 of the previous Office action.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

All Post-Allowance Correspondence concerning this application must be mailed to:
Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or you can fax them to the Office of Patent Publications at 703-872-9306, in order to expedite the handling of such correspondence as amendments under 37 CFR 1.312; information disclosure statements, and formal drawings. Sending Post-Allowance papers to Technology Center 1600 will only cause delays in matching papers with the case.

For information concerning status of correspondence sent after receipt of the Notice of Allowance, please contact the Correspondence Branch at (703) 305-8027. The Notice of Allowance also has an insert containing contact information on other items, including Issue Fees, receipt of formal drawings and the status of the application.



ZACHARY C. TUCKER
PRIMARY EXAMINER